

REMARKS

Status of the Application

In the Office Action, claims 1-10 were rejected. In the present response, claims 10, 13, 15, 31, 33, 35, 37 have been amended, and claims 14 and 28 have been canceled without prejudice or disclaimer of the subject matter thereof, so that claims 10-13, 15-27, and 29-37 are pending.

Claims 10, 31, 33, 35, and 37 have been amended to further define the rear face as having a "smooth high-gloss surface."

Claims 13 and 15 have been revised to accommodate the revision of claim 10.

Rejection Under 35 U.S.C. §102

Claims 10-12, 15-18, 20-24, 26, 29-31, 33 and 35 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,532,045 to Wade. Claims 10-12, 16-19, 21-24, 29-31, 33, 35, and 37 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4, 877,657 to Yaver.

Rejection as to Wade

The Examiner asserts that Wade teaches a decorative vehicle trim part that "comprises a transparent plastic material 20 having an external surface (the surface facing the viewer: the front face) and an internal face (the surface facing the vehicle body: the rear face)". The Examiner further asserts that the "internal (rear) surface is coated with a colored or pigmented adhesive 30 to match or complement either the interior or exterior colors of the car", and that the "part is produced by applying the lacquer to the rear face of the material 20".

The Examiner argues that the colored or pigmented adhesive of Wade "reads on applicant's claimed opaque lacquer layer of either a colored lacquer or effect-producing lacquer". The Examiner indicates that he has given the term "lacquer" "the broadest reasonable interpretation consistent with the common meaning known by one of ordinary skill in the art: 'any of various clear or colored synthetic organic coatings that typically dry to form a film by the evaporation of solvent'." The Examiner further argues that "the film forming adhesive components taught by Wade

include some of the film-forming lacquer components disclosed by applicant”, and therefore “there is no evidence of record that the colored or pigmented adhesive coating of Wade is excluded by applicant’s definition of the term ‘lacquer’.”

Applicants, however, respectfully disagree with the Examiner because contrary to the Examiner’s assertions, an “adhesive” and a “lacquer” are terms of art that a person of ordinary skill in the art would recognize as enjoying two separate and distinct meanings. The Examiner, however, in responding to Applicants’ previous arguments regarding this difference, asserts that it is not his “position that *all* adhesives are lacquers or *vice versa*”, but rather that “the specific adhesive of Wade reads on a lacquer within the context of applicant’s invention.” The Examiner also asserts that the “pigmented (i.e., decorative) adhesion layer of Wade forms a coating and, consequently, reads on lacquer according to the ordinary meaning thereof.”

Applicants, however, respectfully disagree with the Examiner and direct the Examiner’s attention to column 5, lines 54-56 of Wade, wherein Wade indicates that adhesive 30 is applied to substrate 20 by being “coated” across metallized material 20. Wade, however, is NOT stating that the adhesive 30 is a “lacquer”; he is simply indicating how the adhesive 30 is being applied to the material 20. I can coat a pan with oil, or coat my lips with chapstick, but have not applied a lacquer to the pan or my lips any more than has Wade. Indeed, just because the adhesive of Wade and the lacquer of Applicants’ claimed invention are both being applied by being coated onto a substrate does not mean that the adhesive of Wade reads on the “lacquer” of Applicants’ claimed invention.

In fact, unlike the lacquer of Applicants’ claimed invention, the adhesive of Wade is being used to adhere two substrates together. Applicants direct the Examiner’s attention to column 6, lines 32-40 of Wade, wherein Wade indicates that adhesive 30 is used to adhere substrate material 40 to polymeric material 20, and that the adhesive 30, which has been “coated” onto polymeric material 20, is cured “to prevent separation of substrate material 40 from polymeric material 20”. The adhesive of Wade is therefore being utilized in accordance with the ordinary meaning of the term “adhesive”, which Applicants previously pointed out is defined at pages 22-23 of *Hawley’s Condensed Chemical Dictionary, Thirteenth Edition* (Revised by Lewis, Sr., Richard J., published by John Wiley & Sons, Inc. 1997) as

meaning "[a]ny substance, inorganic or organic, natural or synthetic, that is capable of bonding other substances together by surface attachment."

In contrast, Applicants are utilizing a colored or effect-producing opaque lacquer—and NOT an adhesive—to coat the rear face of a transparent plastic material, wherein although the lacquer at some level adheres to the surface of the plastic material being coated is NOT adhering two substrate materials together in accordance with the ordinary meaning of the term "adhesive", wherein such ordinary meaning is defined in Hawley's Condensed Chemical Dictionary, and as pointed out hereinabove, embraced by the disclosure of Wade.

While the Examiner asserts that "applicant's definition of 'adhesive' requires only that such a substance be 'capable of bonding'", Applicants respectfully assert that the Examiner is misinterpreting the wording of the asserted definition, wherein such wording indicates that an "adhesive is capable of bonding other substances together by surface attachment". Applicants further assert that what is meant by "bonding other substances together via surface attachment" is further evidenced by column 6, lines 32-40 of Wade, wherein Wade indicates that adhesive 30 is used to adhere substrate material 40 to polymeric material 20, and that the adhesive 30, which has been "coated" onto polymeric material 20, is cured "to prevent separation of substrate material 40 from polymeric material 20". As a result, a person of ordinary skill in the art would understand the bonding achieved by an adhesive to be of the type that bonds at least two substrates together so as to prevent the substrates from coming apart.

In contrast, Applicants respectfully assert that a person of ordinary skill in the art would understand that although a colored or effect-producing lacquer is, at least on some level, adhering to a substrate, it is not capable of adhering two substrates together so as to provide the same type of strong bond that an adhesive is able to provide. Instead, as pointed out in the previously filed response, a person of ordinary skill in the art would understand a lacquer to be a protective or decorative coating that dries primarily by evaporation of solvent, rather than by oxidation or polymerization.

As an adhesive and a lacquer enjoy different properties, and therefore enjoy different meanings, Applicants respectfully request that the Examiner interpret the language of Applicants' claimed invention in accordance with the separate and distinct meanings accorded to each term, and stop attempting to encompass what

Wade has clearly described as an adhesive with what Applicants' have clearly described as a lacquer. As Wade discloses an adhesive and Applicants' claim a lacquer, and an adhesive does not read on a lacquer, Wade fails to disclose all of the limitations of Applicants' claimed invention. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

Rejection as to Yaver

The Examiner asserts that "Yaver teaches a decorative vehicle trim part" that "comprises a transparent plastic core 11 having front and rear faces with an opaque lacquer layer disposed directly on the rear face and a transparent film overlay disposed on the front face".

Applicants, however, assert that as claims 10, 31, 33, 35 and 37 require the rear face to have "a smooth high-gloss surface", Applicants' claimed invention is novel over Yaver. Applicants direct the Examiner's attention to column 3, lines 46-62 of Yaver, wherein Yaver expressly states that the UV curable coating applied to the underside of transparent or translucent core 11 is mechanically abraded or embossed so as to form a pattern, and that the opaque layer is only then subsequently applied to such abraded or patterned surface. An abraded or patterned surface is not "a smooth high-gloss surface" in accordance with Applicants' claimed invention, and therefore Yaver has failed to disclose all of the limitation of Applicants claimed invention. In fact, such a disclosure on its face expressly teaches away from Applicants' claimed invention. As a result, Applicants respectfully assert that the claimed invention is novel over Yaver. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

Rejection under 35 U.S.C. §103

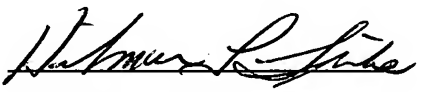
Claims 13, 14, 19, 25, 27, 28, 34 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,532,045 to Wade. Claim 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,532,045 to Wade in view of EP No. 0 329 336 to Balloni, or in the alternative, in further view of GB Patent No. 2 244 283 A to Christopherson. Claims 34 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,877,657 to Yaver.

Applicants, however, respectfully submit that Applicants' claimed invention is not obvious over either Wade, either alone or in combination with Balloni and/or Christopherson, or Yaver for the same reasons as already set forth hereinabove. Specifically, Section 2143.03 of the MPEP indicates that "all the claim limitations must be taught or suggested by the prior art" to establish a *prima facie* case of obviousness. However, as Applicants have already explained hereinabove, Wade in view of Balloni and Christopherson, and Yaver fail to teach ALL of the limitations of Applicants' claimed invention, and therefore the Examiner has not established a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections.

SUMMARY

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and therefore respectfully solicit a Notice of Allowance. In order to expedite disposition of the case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due that is unaccounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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